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Supreme Court of the United States
October Term, 1947

No. 784

WHITIN MACHINE WORKS, a corporation,
Petitioner,

vs.

WILLIAM G. REYNOLDS, EDGAR A. TERRELL,
and THE TERRELL MACHINE COMPANY, a
corporation,
Respondents.

**PETITIONER'S REPLY TO RESPONDENTS' BRIEF
OPPOSING THE GRANT OF THE WRIT.**

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Respondents resort to the familiar device of referring repeatedly to the findings as if this Court were precluded by them. The simple fact is, of course, that the grounds on which the petition is based involve the correct application of the *law*.

However, in view of the tenor of respondents' brief, petitioner believes that this Court should be enlightened regarding the state of the record below and the proceedings there regarding it.

At the outset of the argument in the Court of Appeals the Presiding Judge informed petitioner in no uncertain terms that its printed record was too large, that the Court simply would not take the time to read it, and that a record of such size was in violation of the rule of the Circuit.* Re-

* What the rule in question requires is "An appendix (or supplement to the brief) which, in addition to what is set out in section 1 above, shall contain such parts of the record material to the questions presented as the appellant or petitioner desires the court to read." Believing that in so doing it was complying with the rule, petitioner had submitted a printed record incorporating less than 600 pages of testimony out of the more than 1200 which comprised the trial record.

spondents, it appeared, had received previous notice of what the Court's attitude would be, because at the opening of the session on the day of the hearing respondents submitted an already printed, abridged version of its record. Faced with the prospect of having no record before the Court, and in complete ignorance of how much of a record it could submit with any prospect of its being read, petitioner hastily prepared and filed a second printed record boiled down to a meagre one hundred pages, omitting a considerable amount of the cross examination of Reynolds and the co-owner of the patent, which petitioner had thought the Court of Appeals should read. Obviously, petitioner has no way of knowing just what record the Court of Appeals did read, or to what extent petitioner suffered by the involuntary curtailment of the testimony.

The following brief remarks concerning respondents' discussion of the five grounds on which the writ is sought are believed to merit attention:

I.

Having conducted their campaign so that no relief is possible by way of conflict of decisions, respondents now seek to avoid the force of this ground by contending that the patent monopoly dominates only a part of the cotton textile machine industry. Petitioner is proceeding in the belief that the exercise of the discretionary powers of this Court is called for when, as is indisputably the fact here, the public finds itself in a position where the only two large sources of supply of machinery much in demand and of importance to the textile industry have fallen under the domination of a single patent which has been so manipulated as to confine the litigation to one circuit only.

II.

As to failure of the patent to comply with U. S. 4888, it is noteworthy that even at this juncture respondents fail to enlighten this Court as to the nature of the supposed invention except in terms of such meaningless generalities as "new principles" (p. 4), "control" (p. 5), "the underlying principle of control" (pp. 5, 6), "the Reynolds principle" (p. 14), and "new concepts" (p. 18)—all without the slightest reference to any kind or construction of mechanism. That is precisely the vice of the claims in suit.

Respondents argue that avoidance of twist is important but that was exactly what the *first* (expired) Reynolds patent taught; and besides, there is no evidence that it makes a whit of difference in the method or the final product. It is another phantom and is not in the claims.

Claim 25 is now said to be "for a combination of elements (1) to fold the sliver, and (2) to take up the slack in portions of the cross-sections of the sliver occasioned by the folding." As to what these "elements" comprise respondents' brief is necessarily silent, because reference to claim 25 (quoted at p. 14 of the petition) shows that they are characterized solely as "means".

The Court of Appeals took the view that "even if [mechanism] claims 25 to 28 * are disregarded, plaintiff was entitled to relief under claims 15 and 22" (the method claims). Respondents, on the other hand, now advise this Court (p. 21) that nothing would be accomplished by any inquiry concerning the *method* claims because "the holding of the Circuit Court to the effect that respondent [sic] infringes mechanical claims 25, 27 and 28 would stand." Thus, the mechanical claims are the prop which supports the method claims, and at the same time the method claims are the prop which supports the mechanical claims. The need for the intervention of this Court is surely indicated.

* Claim 26 was not in suit.

III.

Under this point number we find no answer to the third ground of the petition. The obvious violation of the statute by these "mechanical-method" claims is indeed of great importance to the public and consideration of them, we believe, will not be ruled out by respondents' mere assertion (p. 17) that "There is no such question in the case."

IV.

The Court will not fail to note the meaningless generalities (p. 18) again used to characterize what the second Reynolds patent is supposed to have added to the first, namely, "two new concepts with practical means for using them"; "new concepts and means [which] convert failure into success"; and "they are covered by process and mechanical claims in the second patent".

V.

As to whether proof of sale of a machine is acceptable as proof of use of the process which the machine is designed to perform, we are informed now (p. 20) that respondents are relying in part upon some novel presumption, and more importantly, upon "evidence to the effect that petitioner actually *used* the infringing device for the purpose of making cotton roving". In support of this and the following assertion (that petitioner "operated the infringing device for the purpose of making cotton roving at J. & P. Coats for a time") respondents even supply a record reference, namely, 2 App. 351.

If the Court will turn to this reference, it will find it to be to a memorandum by an employee of petitioner referring to the then recent completion and erection of certain experimental roving frames. However, what the Court will

also observe is that the memorandum in question is dated May 13, 1936, or *five years before the patent in suit issued*. It is utterly fantastic that this or any other Court should be told that experimental use of a machine in 1936 is "evidence" of infringement of a patent which did not issue until five years later, in 1941; but such is the contention which respondents advance.

Further ignoring the law, respondents also urge (p. 21) that "it is better, as a practical matter, to hold the manufacturer responsible at the source * * * than to compel respondents to sue all the mills that purchase [and actually use] such machines." Of course it is more "practical", from respondents' point of view. That is precisely the scheme which has enabled respondents to avoid any possibility of conflict of decisions between circuits. And at that the respondents did not pursue the manufacturers "at the source" (the Whitin machine being manufactured in Massachusetts and the Saco-Lowell machine in Maine), but secured jurisdiction over service branches of Whitin and Saco-Lowell by way of the North Carolina court. It is asking too much to believe that this strategy was contrived and twice followed other than for the express purpose of keeping the patent "at home".

Conclusion.

The granting of the writ is earnestly solicited.

Respectfully submitted,

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May 27, 1948.